

REMARKS

Claims 1-28 are pending in this application. By this Amendment, claims 1-28 are amended, and claims 27 and 28 are added. The claims are amended to overcome the rejections under 35 U.S.C. §112, second paragraph, and to better conform to U.S. claim formalities. Support for the amendment to claim 1 to specifically recite that the compound is silane-terminated can be found, for example, in the specification as filed at page 4, lines 4-8; page 10, line 7, through page 11, line 6; page 15, line 11, through page 16, line 4; and in claim 1 as filed. Support for the amendment to claim 14 can be found, for example, in the specification as filed at page 9, lines 4-8. Support for the amendment to claim 22 can be found, for example, in the specification as filed at page 11, line 19, through page 12, line 3. Support for new claim 27 can be found, for example, in the specification as filed at page 8, line 20, through page 9, line 27, and page 23, lines 23-25. Support for new claim 28 can be found, for example, in the specification as filed at page 19, line 5. No new matter has been added.

I. Objection To Claims

The Office Action objects to claim 20 as allegedly being unclear. Without admitting the propriety of the rejection, Applicant has amended claim 20 to more clearly reflect the subject matter of the claim.

Accordingly, withdrawal of the objection is respectfully requested.

II. Rejection Under 35 U.S.C. §112, Second Paragraph

The Office Action rejects claims 14 and 17-21 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. Applicant has amended the claims to remove any language containing both a broad recitation and a specific embodiment recitation.

Accordingly, withdrawal of the rejection is respectfully requested.

III. Rejection Under 35 U.S.C. §102(b)

The Office Action rejects claims 1, 6-19 and 22-24 under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 6,403,175 ("Speier"). Applicant respectfully traverses this rejection.

Speier describes a water-based cold end coating composition comprising a water-based organopolysiloxane that is subsequently subjected to a cross-linking step in the temperature range of from 100 to 350°C. Speier column 2, lines 50-65, and column 4, lines 3-6. Speier describes an alkoxy silane, but this alkoxy silane is then used in a water-based dispersion. Speier, column 2, lines 55-62. It is well known in the art that an alkoxy silane (-Si-OR) will hydrolyze in contact with water to form silanols (-Si-OH) and the corresponding alcohol (ROH), and then will condense to form siloxanes (-Si-O-Si-). Further, Speier specifically describes the disclosed compound as an organopolysiloxane. Thus, Speier describes an organosiloxane, not an alkoxy silane used in deriving a silane-terminated compound.

Conversely, the primer composition of claim 1, which recites a silane-terminated compound, will comprise silane groups, not siloxane groups. Speier can not derive a silane-terminated compound, as described above.

Additionally, claim 22 recites a compound containing silane groups, and therefore also differs from the compounds disclosed in Speier. Therefore, Speier does not describe the primer composition of claim 1 or the compound of claim 22. Accordingly, Speier fails to anticipate claims 1, 6-19 and 22-24.

With regard to new claim 28, which recites a primer comprising a solution that is free of water, claim 28 is also clearly not anticipated by Speier. Speier specifically requires the compound therein to be water-based, so as to derive the required organopolysiloxane.

With regard to new claim 27, Speier describes a water-based cold end coating that is cross-linked in the temperature range of from 100 to 350°C. This temperature range is necessary for cross-linking because Speier specifies use of a blocked polyisocyanate as a cross-linker. See Speier, column 8, lines 42-43. To prevent cross-linking of the water-based cold end coating prior to application, the coating in Speier must comprise a blocked polyisocyanate cross-linker, or the water will hydrolyze the cross-linker and solidify the coating before desired. Heating the coating to initiate cross-linking is thus required so as to remove the blocker from the polyisocyanate and allow cross-linking to occur.

The primer composition of claim 27, however, does not recite a blocked polyisocyanate cross-linker. Thus, the primer composition does not require heating to initiate cross-linking. Instead, because water is not in the composition, free polyisocyanate cross-linker can be used, which allows cross-linking at room temperature through activation with water in the air. Therefore, as Speier describes only a blocked polyisocyanate cross-linker, Speier does not describe the composition of claim 27. Accordingly, Speier also does not anticipate claim 27.

With regard to claim 15, claim 15 describes a compound that is the product of a cross-linking agent and an intermediate product that is the reaction product of polyisocyanate and the silane of formula (I). Speier fails to disclose the compound of claim 15, failing to disclose at least the use of an intermediate reaction product, as is recited in claim 15. Therefore, Speier also fails to anticipate claim 15.

For at least the reasons discussed above, Speier fails to anticipate any of the present claims. Accordingly, withdrawal of the 35 U.S.C. §102(b) rejection is respectfully requested.

IV. Rejections Under 35 U.S.C. §103(a)

A. Speier

The Office Action rejects claims 2-5 and 25-26 under 35 U.S.C. §103(a) as allegedly being unpatentable over Speier. Applicant respectfully traverses this rejection.

For at least the reasons discussed above, Speier fails to anticipate or render obvious claim 1. Claim 1 recites a primer comprising a silane-terminated compound, whereas Speier describes a organopolysiloxane. Further, as was discussed above, the water-based nature of the compound described in Speier makes it impossible for formation of compounds comprising silane termination. Speier does not disclose the primer of claim 1, and also fails to provide reason or rationale that would have led one having ordinary skill in the art to the primer of claim 1. Accordingly, as Speier fails to render obvious independent claim 1, Speier also fails to render obvious dependent claims 2-5 and 25-26.

Additionally, as the Office Action admits, the prior art fails to disclose the use of two silane compounds in concert, as is recited in claim 2. Speier provides no reason or rationale for one having ordinary skill in the art to have created a primer composition including a compound derived from both a silane according to formula (I) and a silane according to formula (I'), as recited in claims 2-5. Accordingly, Speier does not render obvious claims 2-5.

As discussed above, Speier does not render obvious claim 1. Therefore, Speier does not render obvious the method of claims 25 and 26, relating to the application of the primer of claim 1.

For at least the reasons discussed above, Speier does not render obvious claims 2-5 and 25-26. Accordingly, withdrawal of the rejection is respectfully requested.

B. Speier In View Of Ryan

The Office Action rejects claims 20 and 21 under 35 U.S.C. §103(a) as allegedly being unpatentable over Speier in view of U.S. Patent No. 5,342,867 ("Ryan"). Applicant respectfully traverses this rejection.

As discussed above, Speier discloses a water-based composition, and it is well known that water will hydrolyze silane and isocyanate groups. Accordingly, Speier does not describe a similar composition to those recited in claim 1, 20 and 21, which comprise a silane-terminated compound.

Ryan discloses a filler and a solvent, but fails to remedy the deficiencies of Speier. Therefore, combining the filler and solvent of Ryan with the water-based coating of Speier will fail to produce the primer compound of claim 1.

Thus, neither Speier nor Ryan, whether read separately or in concert, render obvious claims 20 and 21. Accordingly, withdrawal of the 35 U.S.C. §103(a) rejection based upon Speier and Ryan is respectfully requested.

IV. Information Disclosure Statement

Applicant requests consideration of European Publication No. 1006132. Applicant properly indicated the relevance in the Information Disclosure Statement by submission of an English-language version of the International Search Report identifying EP 1006132 as a category A reference. As set out in MPEP §609.04(a)(III), this was a concise explanation of the reference sufficient for the reference to have been considered.

For completeness, Applicant also herewith provides an Abstract of the reference.

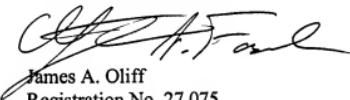
A clean Form 1449 listing EP 1006132 is provided. Applicant requests the Examiner sign and return the Form, confirming consideration of the reference.

V. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-28 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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